

## **REMARKS**

This Amendment is in response to the final Office Action dated December 27, 2006 and addresses the rejections included therein.

### **Pending Claims**

The subject application was originally filed with three (3) claims. In prior Amendments, Applicant added claims 4-10. In the present Amendment, Applicant has cancelled claims 1-4 and 6-7 without prejudice to presentation of these claims, or the subject matter recited therein, in this or a later filed case. Applicant has also added new claims 11-13. Upon entry of this Amendment, claims 5 and 8-13 will be pending in the subject application.

### **Summary of Office Action**

In the final Office Action dated December 27, 2006, the Examiner:

- (1) rejected claims 1-10 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-11 of U.S. Patent No. 6,691,403 ("the '403 patent").

### **Annotated Version of Amended Claim 5**

Pursuant to the Examiner's request, Applicant has provided below an annotated version of amended claim 5 that includes reference numerals in parentheses after each element:

5. A tool (10) for cutting and stripping a sheath (12) from an electrical cable (14), the electrical cable (14) having a spaced pair of insulated power conducting wires (16), a ground wire (18) disposed between the power conducting wires (16), and the sheath (12) surrounding the power conducting (16) and ground (18) wires, the sheath (12) having a pair of spaced side portions (12A) that contain the power conducting wires (16) and a central portion (12B) disposed therebetween that contains the ground wire (18), the tool (10) comprising:

- a) a pair of levers (30, 32) having jaw (38,40), boss and handle (34,36) portions;
- b) a pivot (42) joining the boss portions to enable relative movement of the levers (30, 32) about the pivot (42) between open and closed positions;

- c) a spring (50) positioned between the handle portions to bias the handle portions away from each other;
- d) the jaw portions (38,40) each having blade sections (24C, 26C), each blade section (24C, 26C) having a set of three aligned cutting parts of a cutting edge (24, 26), the three cutting parts including a spaced pair of end cutting parts (24A, 26A) configured to at least partially cut through the side portions (12A) of the sheath (12), and a raised middle cutting part (24B, 26B) provided between the end cutting parts (24A, 26A) and configured to cut the central portion (12B) of the sheath (12); and
- e) the cutting parts on each blade section together forming a cable receiving opening (54) when the levers (30, 32) are in the closed position, the cable receiving opening (54) is sized such that, when the levers (30, 32) are moved from the open to the closed position, the perimeter of the sheath (12) is cut.

**Annotated Version of Amended Claim 9**

Pursuant to the Examiner's request, Applicant has provided below an annotated version of amended claim 9 that includes reference numerals in parentheses after each element:

1. A tool (10) for cutting and stripping a sheath (12) from an electrical cable (14), the electrical cable (14) having a spaced pair of insulated power conducting wires (16), a ground wire (18) disposed between the power conducting wires (16), and the sheath (12) surrounding the power conducting (16) and ground (18) wires, the sheath (12) having a pair of spaced side portions (12A) that contain the power conducting wires (16) and a central portion (12B) disposed therebetween that contains the ground wire (18), the tool (10) comprising:
  - a) a pair of levers (30,32) having jaw (38,40), boss and handle (34,36) portions;
  - b) a pivot (42) joining the boss portions to enable relative movement of the levers (30,32) about the pivot (42) between open and closed positions;

- c) a spring (50) positioned between the handle portions to bias the handle portions away from each other;
- d) the jaw portions (38,40) each having blade sections (24C,26C) for coactively circumferentially severing the sheath (12) when the levers (30,32) are moved from the open to the closed position;
- e) each blade section (24C,26C) having a set of three aligned cutting parts of a cutting edge (24,26), the set of three cutting parts including a spaced pair of end cutting parts (24A,26A) being contoured to cut the side portions (12A) of the sheath (12) and a raised middle cutting part (24B,26B) between the end cutting parts (24A,26A) for cutting the central portion (12B) of the sheath (12); and
- f) the cutting parts together forming a cable wire receiving opening (54) when the levers (30,32) are in the closed position, the cable receiving opening (54) being of a configuration smaller than the configuration of the sheath (12), such that the sheath (12) is circumferentially severed when the levers (30,32) are moved from the open to the closed position.

#### **Rejection of Claims 1-10 under 35 U.S.C. § 101**

Initially, since claims 1-4 and 6-7 have been cancelled without prejudice, the rejection of these claims is now moot and should, therefore, be withdrawn.

Regarding claims 5 and 8-10, Applicant notes that a rejection based on double patenting of the “same invention” type finds its support in the language of 35 U.S.C. § 101, which states that “whoever invents or discovers any new and useful process ... may obtain a patent therefor...” (emphasis added). Thus, the term “same invention,” in this context, means an invention drawn to identical claimed subject matter since the claims of a patent define the invention. Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In re Vogel, 422 F.2d 438 (CCPA 1970); and In re Ockert, 245 F.2d 467 (CCPA 1957). According to the court in In re Vogel, “a good test, and probably the only objective test, for ‘same invention,’ is whether one of the claims could be literally infringed without literally infringing the other.” In re Vogel, 164 USPQ 619, 622 (CCPA 1970). Moreover, relying on the decision in In re Vogel, MPEP § 804 states:

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a “halogen” substituent is not identical to or substantively the same as a claim reciting the same compound except having a “chlorine” substituent in place of the halogen because “halogen” is broader than “chlorine.”

In other words, a 35 U.S.C. § 101 double patenting rejection is only proper when the claim(s) of a patent application are drawn to the exact same subject matter as the claim(s) of an issued patent. Therefore, the claims of the subject application should be compared to the claims of the ‘403 patent, not its specification.

In the subject application, Applicant has amended independent claims 5 and 9 to include a limitation not recited in claims 1-11 of the ‘403 patent. Specifically, Applicant has amended independent claims 5 and 9 to include “a spring positioned between the handle portions to bias the handle portions away from each other” (“the spring limitation”). When applying the In re Vogel test to independent claims 5 and 9, it is clear that a tool that lacks a spring, but includes all other relevant limitations, would not infringe independent claims 5 and 9 (or the claims that depend therefrom), but could possibly infringe one or more claims of the ‘403 patent because these claims do not include the spring limitation. Therefore, independent claims 5 and 9 are not drawn to the exact same subject matter as any of the claims of the ‘403 patent. For this reason, the double patenting rejection to claims 5 and 8-10 based on 35 U.S.C. § 101 should be withdrawn.

### **New Claims**

As discussed above, Applicant has added newly presented claims 11-13. Applicant submits that these new claims do not introduce new matter as they are supported by the specification and drawings of the subject application. Additionally, consideration of these new claims should not require an additional search. Applicant submits that new claims 11-13 are patentable in light of the prior art of record for the same reasons as discussed above.

### **Conclusion**

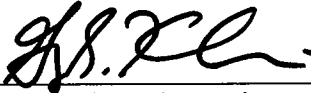
In view of the remarks above and the amendments presented herein, it is believed that claims 5 and 8-13 are in condition for allowance and notice to such effect is respectfully

requested. If the Examiner thinks a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at the phone number provided below.

The Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 02-2051, referencing Docket No. 24685-113.

Respectfully submitted,

Dated: April 27, 2007

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